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| 09/981,345      | 10/17/2001  | Ali Abdelaziz Alwattari | 8586                | 5497             |

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EXAMINER

GHALI, ISIS A D

|          |              |
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| ART UNIT | PAPER NUMBER |
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1615

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8/19

## Office Action Summary

Application No.

09/981,345

Applicant(s)

ALWATTARI ET AL.

Examiner

Isis Ghali

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

The receipt is acknowledged of applicants' amendment, filed 03/22/2004.

Claims 1-23 are included in the prosecution.

### ***Claim Rejections - 35 USC § 102***

1. Claims 1, 2, 5-7, 14-16, 18, 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,871,607 ('607).

US '607 disclosed a substance delivery system to deliver substance to a target surface when it is deformed; such system comprises a deformable material (substrate) that hold substance in depressions and/or valleys (pockets) (abstract; col.4, lines 22-35). The above structure is used in lotion impregnated facial tissue, scented strips containing perfumes, medicinal patches, and condiment delivery to a surface (col.18, lines 22-27), and that read on the claimed wipe article. The deformable material is nonwoven film material that can be porous or non-porous, permeable or non-permeable (col.4, lines 55-62) and includes polyethylene and polypropylene (col.9, lines 34-40). The substances that held in the depressions are in the form of gel or suspension (col.4, lines 39-41). The height of the depressions (that will be same as the height of the protrusion) is from 0.01 cm to 0.03 cm, i.e. 0.1 to 0.3 mm (col.9, lines 17-18). The width of the depression (that will be the center to center spacing of the protrusions) is from

0.08 cm to 0.15 cm, i.e. 0.8 to 1.5 mm (col.9, lines 8-11). The ratio of height (depth) to width will be from 1:8 till 3:15, and that read on the claimed ratio of at least 1:2, and between 0.7:1 and 2.8:1. The reference disclosed deformation of the system can be caused by tensile force applied substantially parallel to the plane of the deformable material (col.5, lines 15-30), and that parallel force reads on the shear force because the shear force means deformation of an elastic body caused by forces that tend to produce an opposite but parallel sliding motion of the body's planes. The reference teaches that the structure comprising depressions containing functional substances and will deliver the substances to the target surface upon contact and forms a continuous pattern (col.7, lines 1-9), and that reads on forming a replica on the target surface.

The limitations of claims 1, 2, 5-7, 14-16, 18, 20 and 22 are met by US '607.

### ***Response to Arguments***

Applicant's arguments filed 03/22/2004 have been fully considered but they are not persuasive.

Applicants traverse the above rejection by arguing that the dimensions of the depressions disclosed by the reference are not the same as disclosed by applicant and this cause the depressions to fold under pressure. The reference does not teach how the micropockets will deliver the active agent to the target surface.

In response to the above arguments, the examiner is pointing out to the figures of the '607 reference where they show the distance between center to center is the same as the distance between center of the base to center of the base and thus reads on the

width of the depressions. The calculated dimensions read on and encompass the claimed dimensions. The height of the depressions (that will be same as the height of the protrusion) is from 0.01 cm to 0.03 cm, i.e. 0.1 to 0.3 mm. The width of the depression (that will be the center to center spacing of the protrusions) is from 0.08 cm to 0.15 cm, i.e. 0.8 to 1.5 mm. The ratio of height (depth) to width will be from 1:8 till 3:15, and that read on the claimed ratio of at least 1:2, and between 0.7:1 and 2.8:1. The reference disclosed deformation of the system can be caused by tensile force applied substantially parallel to the plane of the deformable material, and that parallel force reads on the shear force because the shear force means deformation of an elastic body caused by forces that tend to produce an opposite but parallel sliding motion of the body's planes. It is inherent that the article having the same structure will have the same physical properties as resistance to specific forces and yielding to others. In any events, the properties do not impart patentability to the claims directed to product since all the elements of the product are disclosed by the reference.

2. Claims 1-3, 5-16, and 18 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by PGPUB 2002/0102392 ('392) that has the effective filing date of Dec. 28, 2000.

PGPUB '392 disclosed a laminate structure formed of first substrate and second substrate that have pockets formed in between the two substrates that contain functional material and are small in size having width to height ratio less than 10 (abstract) and that reads on applicant's ratio 1:2 and 0.7:1 to 2.8:1. The laminate

structure used for bandage, dressing, support for one or more parts of the body (page 8, paragraph 0077), and that read on the wipe article disclosed by applicants since dressing as wipes both absorb the body exudates. The substrates are nonwoven webs of polyethylene or polypropylene, or polyvinyl alcohol (page 3, paragraph 0030), and are permeable or impermeable (page 4, paragraph 0036). The substrate further contains elastomeric material (page 4, paragraph 0043). The functional material can be particles (solid) or liquid as oil, and includes deodorant, colorant, fragrance, and drugs (page 6, paragraph 0059 and 0060; page 8, paragraph 0077). The height (depth) of the pocket is between about 0.005 to 0.4 inches, i.e. 0.127 to 10 mm (page 8 paragraph 0072). The width of the pockets is calculated by the examiner to be less than 100 mm, i.e. less than 10 times as the depth. The length of the pocket is disclosed by the reference to be between 0.0625 to 2 inches, i.e. 1.5875 to 50 mm (page 8, paragraph 0073). Thus the dimensions of the pocket disclosed by the reference read on the dimensions of the instant claims. Subjecting the substrate to shear force that deform the wall of the pockets and release the functional substance is an intended use and not patentably significant in product claims.

Thus, the limitations of claims 1-3, 5-16 and 18 are met by the PG PUB '392.

### ***Response to Arguments***

Applicant's arguments filed 03/22/2004 have been fully considered but they are not persuasive.

Applicants traverse the above rejection by arguing that the reference does not teach any intension to release the functional substance from the pocket upon application of shear forces.

In response to the above argument, the examiner position is that the rejected claims are directed to product, and all the elements of the product are disclosed by the reference. The intended use does not impart patentability to product claim. Claiming of a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. The recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

3. Claims 1-16, 18, 23 are rejected under 35 U.S.C. 102(e)(2) as being anticipated by US 6,429,350 ('350).

US '350 disclosed an article that can be a wipe such as baby wipe (col.8, lines 29-34; col.10, lines 52-53). The article comprises a liquid permeable layer and a substantially liquid impermeable layer, wherein at least one of the layers includes plurality of pockets (col.2, lines 44-50). The above layers that contain the pockets are nonwoven and are made of polyethylene or polypropylene (col.6, lines 34-45). The pockets have depth of at least 2.5 mm and preferable ranges from 3.8-13 mm, and have width ranging from 5-25 mm (col.4, lines 29-36; col.9, lines 41-55). The ratio of the

depth to width is calculated by the examiner to be 1:2. The pockets disclosed to be circular or elliptical, and that means the length of the pocket will be at least 5-25 mm. The reference teaches that the pockets are separated apart by distance of 2.5 to 25 mm (col.9, lines 59-61), and since the diameter of the pockets ranges from 5-25 mm, this means 1 cm<sup>2</sup> will have from 1-100 pockets. Thus, all the dimensions disclosed by the reference read on the claimed dimensions. The pockets can be in more than one layer (col.2, lines 43-50). The pockets contain superabsorbent (read on wettable material claimed by applicants), and the pockets that do not contain the superabsorbent can contain odor absorbent (deodorant), fragrant material, lotion, emollient, and antimicrobials (medicinal agent), (col.5, lines 39-50). The nonwoven webs can further include an elastomer (col.7, lines 14-16). Subjecting the substrate to shear force that deform the wall of the pockets and release the functional substance is an intended use and not patentably significant in product claims.

The limitations of claims 1-16, 18 and 23 are met by US '350.

### ***Response to Arguments***

Applicant's arguments filed 03/22/2004 have been fully considered but they are not persuasive.

Applicants traverse the above rejection by arguing that there is nothing in US '350 teaching or suggesting that the functional substances contained in the pockets is intended to be released therefrom upon application of shear force. In fact, the pockets contain functional materials such as superabsorbents that one would not want to be



released onto a baby's skin. Instead, the superabsorbent materials stay contained in the pockets of the absorbent article where they act to absorb urine.

In response to the above argument, the examiner position is that the rejected claims are directed to product, and all the elements of the product are disclosed by the reference. The intended use does not impart patentability to product claim. Claiming of a new use, new function or unknown property, which is inherently present in the prior art, does not necessary make the claim patentable. The recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Claim Rejections - 35 USC § 103***

4. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of US '607 or PGPUB '392 in view of US 6,063,397 ('397).

US '607 teaches a substance delivery system to deliver substance to a target surface when it is deformed, such system comprises a deformable material (substrate) that hold substance in depressions and/or valleys (pockets) (abstract; col.4, lines 22-35). The above structure is used in lotion impregnated facial tissue, scented strips containing perfumes, medicinal patches, and condiment delivery to a surface (col.18, lines 22-27) and that reads on the wipe article disclosed by applicants. The deformable material is nonwoven film material that can be porous or non-porous, permeable or non-

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permeable (col.4, lines 55-62) and includes polyethylene and polypropylene (col.9, lines 34-40). The substances that held in the depressions are in the form of gel or suspension (col.4, lines 39-41). The height of the depressions (that will be same as the height of the protrusion) is from 0.01 cm to 0.03 cm, i.e. 0.1 to 0.3 mm (col.9, lines 17-18). The width of the depression (that will be the center to center spacing of the protrusions) is from 0.08 cm to 0.15 cm, i.e. 0.8 to 1.5 mm (col.9, lines 8-11). The ratio of height (depth) to width will be from 1:8 till 3:15, and that read on the claimed ratio of at least 1:2, and between 0.7:1 and 2.8:1. The reference disclosed deformation of the system can be caused by tensile force applied substantially parallel to the plane of the deformable material (col.5, lines 15-30), and that parallel force reads on the shear force because the shear force means deformation of an elastic body caused by forces that tend to produce an opposite but parallel sliding motion of the body's planes. The reference teaches that the structure comprising depressions containing functional substances and will deliver the substances to the target surface upon contact and forms a continuous pattern (col.7, lines 1-9), and that reads on forming a replica on the target surface.

PGPUB '392 teaches a laminate structure formed of first substrate and second substrate that have pockets formed in between the two substrates that contain functional material and are small in size having width to height ratio less than 10 (abstract) and that reads on applicant's ratio 1:2 and 0.7:1 to 2.8:1. The laminate structure used for bandage, dressing, support for one or more parts of the body (page 8, paragraph 0077), and that read on the wipe article disclosed by applicants since dressing as wipes both absorb the body exudates. The substrates are nonwoven webs

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of polyethylene or polypropylene, or polyvinyl alcohol (page 3, paragraph 0030), and are permeable or impermeable (page 4, paragraph 0036). The substrate further contains elastomeric material (page 4, paragraph 0043). The functional material can be particles (solid) or liquid as oil, and includes deodorant, colorant, fragrance, and drugs (page 6, paragraph 0059 and 0060; page 8, paragraph 0077). The height (depth) of the pocket is between about 0.005 to 0.4 inches, i.e. 0.127 to 10 mm (page 8 paragraph 0072). The width of the pocket is calculated by the examiner to be less than 100 mm, i.e. less than 10 times as the depth. The length of the pocket is disclosed by the reference to be between 0.0625 to 2 inches, i.e. 1.5875 to 50 mm (page 8, paragraph 0073). Thus the dimensions of the pocket disclosed by the reference read on the dimensions of the instant claims.

Both of US '607 and PGPUB '392 do not teach the substance included in the pocket to be cleansing agent and conditioning agent at the same time, or anti-wrinkle agents.

US '397 teaches a substrate of nonwoven material made of polyethylene or polypropylene that delivers cleansing agent and conditioning agent at the same time as well as an active agent such as anti-wrinkle agents (abstract; col.2, lines 59-67; col.5, lines 49-62; col.17, line 59). The substrate of the reference increases the cleansing and exfoliation, and optimizes delivery of the conditioning ingredient, and meanwhile is useful for delivering active ingredients to the skin during the cleansing process (col.2, lines 20-34).

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to replace the functional substance in the pockets of the article disclosed by US '607 or PG PUB '392 by the cleansing agent and the conditioning agent or anti-wrinkle agent applied by the substrate disclosed by US '397, motivated by the teaching of the US '397 that the substrate of the reference increases the cleansing and exfoliation, and optimizes delivery of the conditioning ingredient at the same time, and meanwhile is useful for delivering active ingredients to the skin during the cleansing process, with reasonable expectation of success of providing wipe having pockets to deliver cleansing and conditioning agents or anti-wrinkle agent to the skin of the person on need in one single step.

### ***Response to Arguments***

Applicant's arguments filed 03/22/2004 have been fully considered but they are not persuasive.

Applicants traverse the above argument by arguing that there is nothing in the prior art teaching or suggesting the use of these functional materials in a wipe article containing the specific type of micropockets as claimed. US '397 does not have any micropockets at all, let alone the specific type of micropockets claimed herein. The combination of the references would fall short of applicants' claimed invention.

In response to the above applicants' argument the examiner position is that the primary references teach the elements of the claimed article, and the secondary reference is relied upon for the solely teaching of the specific functional agents claimed

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in claims 17 and 19. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case one having ordinary skill in the art at the time of the invention would have been motivated to replace the functional substance in the pockets of the article disclosed by US '607 or PGPUB '392 by the cleansing agent and the conditioning agent or anti-wrinkle agent applied by the substrate disclosed by US '397, motivated by the teaching of the US '397 that the substrate of the reference increases the cleansing and exfoliation, and optimizes

delivery of the conditioning ingredient at the same time, and meanwhile is useful for delivering active ingredients to the skin during the cleansing process, with reasonable expectation of success of providing wipe having pockets to deliver cleansing and conditioning agents or anti-wrinkle agent to the skin of the person on need in one single step.

5. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '350 in view of US 6,280,757 ('757).

US '350 teaches an article that can be a wipe such as baby wipe (col.8, lines 29-34; col.10, lines 52-53). The article comprises a liquid permeable layer and a substantially liquid impermeable layer, wherein at least one of the layers includes plurality of pockets (col.2, lines 44-50). The above layers that contain the pockets are nonwoven and are made of polyethylene or polypropylene (col.6, lines 34-45). The pockets have depth of at least 2.5 mm and preferable ranges from 3.8-13 mm, and have width ranging from 5-25 mm (col.4, lines 29-36; col.9, lines 41-55). The ratio of the depth to width is calculated by the examiner to be 1:2. The pockets disclosed to be circular or elliptical, and that means the length of the pocket will be at least 5-25 mm. The reference teaches that the pockets are separated apart by distance of 2.5 to 25 mm (col.9, lines 59-61), and since the diameter of the pockets ranges from 5-25 mm, this means 1 cm<sup>2</sup> will have from 1-100 pockets. Thus, all the dimensions disclosed by the reference read on the claimed dimensions. The pockets can be in more than one layer (col.2, lines 43-50). The pockets contain superabsorbent (read on wettable material

claimed by applicants), and the pockets that do not contain the superabsorbent can contain odor absorbent (deodorant), fragrant material, lotion, emollient, and antimicrobials (medicinal agent), (col.5, lines 39-50). The nonwoven webs can further include an elastomer (col.7, lines 14-16).

The reference does not teach providing cleansing and conditioning agents from two different layers of the same article.

US '757 teaches an article comprising apertured substrate of nonwoven material such as polyvinyl alcohol, polyethylene, or polypropylene comprising first and second layers that are bonded in some regions and unbonded in other regions, i.e. form pockets (abstract; col.2, lines 40-52; col.4, lines 45-50; col.5, lines 18, 39, 47; col.39, lines 46-50). The article used to deliver surfactant (cleansing agent) and conditioning agent when rubbed against the skin (col.2, lines 25-29; col.4, lines 58-65). One layer can be treated with the surfactant and the other can be treated with the conditioning agent (col.3, lines 61-66).

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to use the wipe of US '350 that can deliver more than one agent to deliver cleansing agent and conditioning agent in different layer as taught by US '757, motivated by the teaching of US '757 that the article comprising both agents provides both functions of cleansing and conditioning in a single use, with reasonable expectation of success of the delivered wipe to deliver more than one beneficial agent to the skin as the cleansing and conditioning agent by simply rubbing single wipe against the skin of the user.

***Response to Arguments***

Applicant's arguments filed 03/22/2004 have been fully considered but they are not persuasive.

Applicant traverse the above rejection by arguing that nothing in US '350 teaching or suggesting that the functional substance contained in the pockets is intended to be released upon application of a shear force. US '757 relates to disposable, personable cleansing articles useful for cleansing the skin or hair. The Examiner notes that US '757 discloses the use of a cleansing agent in one layer and a conditioner in another. Applicants' acknowledge that the use of cleansing agent and conditioning agents are known in the art. However, there is nothing in the prior art teaching or suggesting the use of these functional materials in a wipe article containing the specific type of micropockets claimed herein. The combination of the references would fall short of applicants' claimed invention.

In response to the above argument, the examiner position is that the primary reference teaches the elements of the claimed article, and the secondary reference is relied upon for the solely teaching of the structure of two layers to deliver the cleansing agent and the conditioning agent separately as claimed in claim 19. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In considering the disclosure of the reference, it is proper to take into account not only the



specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case one having ordinary skill in the art at the time of the invention would have been motivated to deliver cleansing agent and conditioning agent in different layer as taught by US '757, motivated by the teaching of US '757 that the article comprising both agents provides both functions of cleansing and conditioning in a single use, with reasonable expectation of success of the delivered wipe to deliver more than one beneficial agent to the skin as the cleansing and conditioning agent by simply rubbing single wipe against the skin of the user.

6. Claims 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '607 in view of PGPUB 2002/0092199 ('199).

US '607 teaches a substance delivery system to deliver substance to a target surface when it is deformed, such system comprises a deformable material (substrate) that hold substance in depressions and/or valleys (pockets) (abstract; col.4, lines 22-35). The deformable material is nonwoven film material that can be porous or non-porous, permeable or non-permeable (col.4, lines 55-62) and includes polyethylene and polypropylene (col.9, lines 34-40). The substances that held in the depressions are in the form of gel or suspension (col.4, lines 39-41). The above structure is used in lotion impregnated facial tissue, scented strips containing perfumes, medicinal patches, and condiment delivery to a surface (col.18, lines 22-27). The height of the depressions (that will be same as the height of the protrusion) is from 0.01 cm to 0.03 cm, i.e. 0.1 to 0.3 mm (col.9, lines 17-18). The width of the depression (that will be the center to center spacing of the protrusions) is from 0.08 cm to 0.15 cm, i.e. 0.8 to 1.5 mm (col.9, lines 8-11). The ratio of height (depth) to width will be from 1:8 till 3:15, and that read on the claimed ratio of at least 1:2, and between 0.7:1 and 2.8:1. The reference disclosed deformation of the system can be caused by tensile force applied substantially parallel to the plane of the deformable material (col.5, lines 15-30), and that parallel force reads on the shear force because the shear force means, as per "THE WEBSTER DICTIONARY II" cited for interest, deformation of an elastic body caused by forces that tend to produce an opposite but parallel sliding motion of the body's planes. The reference teaches that the structure comprising depressions containing functional substances and will deliver the substances to the target surface upon contact and forms

a continuous pattern (col.7, lines 1-9), and that reads on forming a replica on the target surface.

US '607 does not teach the substrate as clothing insert, a shoe insole or as a panty liner.

PGPUB '199 teaches a shoe liner comprising first substrate and second substrate of nonwoven webs and comprising pockets containing functional material in the form of liquid that include odor absorbent, fragrance and germicidal material (abstract; page 1, paragraph 003; page 2, paragraph 0024; page 5, paragraph 0049). The substrate is nonwoven web of polyvinyl alcohol, polyethylene, or polypropylene (page 3, paragraph 0027), and can be permeable or impermeable to liquid (page 3, paragraph 0032).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to apply functional substance to a target surface by applying tensile force on the structure disclosed by US '607 and use it as a shoe liner as disclosed of PGPUB '199 motivated by the teaching of PGPUB '199 that pockets provide comfort to the foot as well as allow the shoe liner to maintain the functionality of the included functional material over an extended period of time, with reasonable expectation of success of the delivered method to provide functional materials to the sole of the user from shoe insole.

**Response to Arguments**

Applicant's arguments filed 03/22/2004 have been fully considered but they are not persuasive.

Applicants traverse the above rejection by arguing that that nothing in PGPB '199 teaches or suggesting that the functional substance contained in the pockets is intended to be released upon application of a shear force. Even if one were to combine the teachings of PG PUB '199 with the substrates disclosed in US '607 as the Examiner suggests the combination would fall short of Applicants' claimed invention.

In response to the above argument, the examiner position is that the primary reference teaches the elements of the claimed article, and the secondary reference is relied upon for the solely teaching of the articles claimed in claim 21. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness

can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In that case, one having ordinary skill in the art would have been motivated by the teaching of the PG PUB '199 that pockets provide comfort to the foot as well as allow the shoe liner to maintain the functionality of the included functional material over an extended period of time, with reasonable expectation of success of the delivered method to provide functional materials to the sole of the user from shoe insole.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

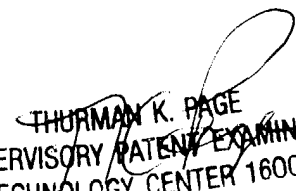
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali  
Examiner  
Art Unit 1615

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600